

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2841

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Applicant: Chee-Yee Chung et al.

Title: RESISTIVE ELEMENT APPARATUS AND METHOD

Docket No.: 884.538US1

Filed: October 12, 2001

Examiner: Tuan Dinh



Serial No.: 09/977,124

Due Date: November 20, 2004

Group Art Unit: 2841

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

☒ A return postcard.

☒ Response to Restriction Requirement (2 pgs.).

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

Customer Number 21186

By: *Ann M. McCrackin*
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22 day of November, 2004.

Chris Hammond

Name

Chris Hammond
Signature

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

(GENERAL)

S/N 09/977,124

PATENT

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Applicant:	Chee-Yee Chung, et al.	Examiner:	Tuan T. Dinh
Serial No.:	09/977,124	Group Art Unit:	2841
Filed:	October 12, 2001	Docket:	884.538US1
Title:	RESISTIVE ELEMENT APPARATUS AND METHOD		
Assignee:	Intel Corporation	Customer No.:	21186

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Office Communication mailed October 20, 2004, and the Restriction Requirement mailed June 15, 2004, the Applicants provisionally elect, with traverse, the claims of Group I (i.e., claims 1-22). Species I is also provisionally elected, as at least species I (FIG. 3) reads on claims 1-22. It is asserted by Applicants that Species II-V also read on the claims of Group I. Again, the Restriction Requirement is traversed on the basis that the case for restriction set forth does not meet the criteria set forth in M.P.E.P. § 806.05(f) for proper restriction between patentably distinct inventions.

The United States Patent Office has taken the position that a distinctness requirement between inventions directed to a process of making and a product is proper if it can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process. M.P.E.P. § 806.05(f) (emphasis in original). In the Office Action, however, the statement of this requirement has been abbreviated so as to leave out the phrase “the process *as claimed* is not an obvious process of making the product and ”. It is then asserted that “In the instant case the method can be made in different processes, for example the step of screening can be replaced by adhesive or soldering a resistive element onto a layer of a circuit board.” This conclusion is improper.

M.P.E.P. § 806.05(f) is directed to a process of making a *product*, not a method. This distinction is emphasized using bold type in the “Examiner Note” portion of the cited section of

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the M.P.E.P. Therefore it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

CONCLUSION

As noted above, the Applicants provisionally elect, with traverse, the claims indicated in the Restriction Requirement included in Group I (i.e., claims 1-22), and Species I (FIG. 3). If the Requirement is continued, the Applicants request cancellation of claims 23-26 without prejudice or disclaimer, and reserve the right to reintroduce them in this Application, or in one or more divisional applications, at a later date.

The Examiner is invited to contact the Applicants' Representative Mark V. Muller at (210) 308-5677, or the undersigned attorney if there are any questions regarding this Response or if prosecution of this Application may be assisted thereby. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHEE-YEE CHUNG, ET AL.

By their Representatives,

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Date Nov. 20, 2004 By Ann M. McCrackin
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